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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,060	11/25/2003	Donal Coveny	TOMK-0001 (122359.00003)	4165
T. Ling Chwang Suite 600 2435 N. Central Expressway Richardson, TX 75080			EXAMINER OH, TAYLOR V	
			ART UNIT 1625	PAPER NUMBER

DATE MAILED: 09/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/722,060

Applicant(s)

COVENEY ET AL.

Examiner

Taylor Victor Oh

Art Unit

1625

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 16 August 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see pages 2-7. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

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It is noted that applicants have filed an Amendment after the Final Rejection on 8/16/05; applicants' attorney has addressed the issues of record. The proposed amendment will not be entered because of the new matter; and, it is not in a condition for allowance.

The Status of Claims

Claims 1-4, 7-9, and 11-15 are pending.

Claims 1-2, 4, 7-9, and 11-15 have been rejected.

Claim 3 is allowable.

Claim Objections

Claims 1, 4, 13, 14, and 15 are objected to because of the following informalities:

In Claim 1, the new phrase "remaining entire 11 or fewer of 11" is introduced before the phrase "R₁ groups are CH₂CO₂K".

In claims 4, 13, and 14, the new phrase "the number of R₁ groups that are CH₂CO₂K independently ranges from 1 to 11" is introduced after the term "alkylation".

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However, the newly introduced phrases "remaining entire 11 or fewer of 11" and "the number of R₁ groups that are CH₂CO₂K independently ranges from 1 to 11" are not present and shown in the original specification. A close inspection of the original claims and specification do not provide antecedent basis for the proposed changes. New matter can not be introduced into specification at any time during the prosecution, unless there is a supporting description that would support the proposed changes. Applicant is required to cancel the new matter in the reply to this Office Action.

In Claim 15, the Claim is objected to under 37 CFR 1.75(c) as being in improper form because of its being dependent on a multiple dependent claim 14. See MPEP § 608.01(n). Accordingly, the claim 15 is not been further treated on the merits.

Claim Rejections - 35 USC § 112

1. Applicants' argument filed 8/16/05 have been fully considered but they are not persuasive.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Claims 1, 4, 7-9, and 11-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claims 1, 4, 13, and 14, the new phrases "remaining entire 11 or fewer of 11" of "R₁ groups are CH₂CO₂K" and "the number of R₁ groups that are CH₂CO₂K independently ranges from 1 to 11" are recited. These phrases have not been described in the original specification (see page 10, line 23; page 11, line 4, and page 17, lines 18-19). Therefore, the addition of the new phrases "remaining entire 11 or fewer of 11" of "R₁ groups are CH₂CO₂K" and "the number of R₁ groups that are CH₂CO₂K independently ranges from 1 to 11" to the claims does not provide antecedent basis for the proposed changes. New matter can not be introduced into specification at any time during the prosecution, unless there is a supporting description that would support the proposed changes. Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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The rejection of Claims 4, 8-9, and 13-15 under 35 U.S.C. 112, second paragraph, has been maintained due to applicants' failure to modify the claims in the amendment .

Claim Rejections - 35 USC § 103

1. Applicants' argument filed 2/28/05 have been fully considered but they are not persuasive.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The rejection of Claims 1-2 , 4, 7-9, and 12-15 under 35 U.S.C. 103(a) as being unpatentable over Harris (WO 95/19974) in view of Aldrich (page 811, 1999) has been maintained with the reasons of the record on 8/24/04.

Applicants' attorney has addressed the issues of record; however, has not rebutted the claim rejections **1-2 , 4, 7-9, and 12-15** under 35 USC 103 (a).

Applicants' Argument

Applicants argue the following issues:

- a. The claimed compounds are partially alkylated as shown in the claims, whereas the Harris' compounds are fully alkylated or non-alkylated.

Applicants' arguments have been noted, but the arguments are not persuasive.

Regarding applicants' argument, the Examiner has noted applicants' arguments. However, on the contrary to applicants' argument, the claims are directed to the compounds having different degrees of alkylation.; the expression is vague and infinite because there are many different degrees of alkylation which can be possible in the compounds of formula I; for example, not only a partial degree of alkylation, but also a full degree of alkylation as shown in Harris' compounds can be applied for the claims 4, 8-9, and 13-15. Therefore, applicants' argument are irrelevant to the issue of the current invention. Thus, the rejection has been maintained.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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9/22/05

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